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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,082	09/02/1999	STEPHEN PETER FITZGERALD	104161	4878

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EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/389,082

Applicant(s)

FITZGERALD ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to Applicants' remarks filed on March 22, 2004.

Claims 1-3, 6-13 and 15-21 are pending.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 6-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westhall (EP 569753) in view of US patent 4,828,386 to Matkovich et al.

Westhall discloses an apparatus for receiving and storing discs. The discs (3) have biologically active substances are bound it. The discs are equivalent to Applicants' chip. The discs are disposed in a tubular receiving element (2). The tubular receiving member is equivalent to Applicants' storage well. According figure 1 of the reference, the discs substantially covers the base of the tube, as recited in claim 3. With respect to claim 4, the spacer elements (4) help to retain the discs in the tube. With respect to claim 10, the abstract of the reference teaches the tube being made of plastic. Figure 3 of the reference shows multiple tubes (1) arranged in a line on a flat retainer member (8).

Westhall differs from the instantly claimed invention in that there is no teaching of hot or cold formed projections for holding the chip within the well. Also, there is no teaching of the use of a plurality of stacking trays.

Matkovich et al teach a device have a plurality of storage well (20). In one embodiment of the reference, Matkovich et al teach a well having projections (72) on the inner surface of the wall of the well. The projection forms a ring around the inner circumference of the well.

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Matkovich et al teaches that the projection serves as a retaining ring. It would have been obvious to one of ordinary skill in the art to incorporate projections into the device of Westhall for aiding in retaining the discs in place, as taught by Matkovich et al.

With respect to claim 9, where a square base is recited, it would have been obvious to one of ordinary skill in the art to make the base of the storage well any shape suitable to sufficiently hold the discs/chips within the well.

With respect to the projections being "hot or cold formed", such limitation involves how to make the projection and is not a patentable limitation in claims directed to an apparatus.

With respect to the trays being arranged in a stack, such would have been obvious to one of ordinary skill in the art to allow easier packaging of the wells and easier shipping.

Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Westhall and Matkovich et al.

Response to Arguments

3. Applicant's arguments filed March 22, 2004 have been fully considered but they are not persuasive. With respect to the obviousness rejection over Westhall in view of Matkovich et al, Applicants argue that one of ordinary skill in the art would not have been motivated to modify Westhall to incorporate a retaining ring because Westhall teaches that the chips (discs) are to be stored and automatically removed/extracted. Applicants assert that incorporating a retaining ring would prevent the discs/chips of Westhall from being automatically removed from the tubular element.

In response, the Examiner would like to point out that Matkovich does not teach that

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the retaining means holds the inserts in the wells permanently or in a manner where the inserts could not be removed from the wells. In fact, Matkovich discloses that in the projection need not be a raised ring or other raised projection in the wall of the storage well – the projection may represent a narrowing of the diameter of the well (col. 10, lines 32-37 of Matkovich). Further, Matkovich, like Westhall, teaches an embodiment where the inserts are removed at various stages of process (col. 8, lines 55-60). Further, at col. 9, lines 20-29, Matkovich teaches additional measures for the inserts to be “locked” into the storage wells, further proving that the retaining ring does not prevent the inserts from being removed.

It is the position of the Examiner that, even though Westhall teaches that the chips/discs are to be removed or extracted, one of ordinary skill in the art would have still been motivated to modify Westhall to incorporate inward projections for better storage of the chips/discs, especially during transport. The projections of Matkovich do not prevent the disc/chips from being removed from the storage well.

With respect to Applicants’ arguments regarding the shape of the base of the storage well, the Examiner would like to point out that generally differences in shape will not support the patentability of a claim. See In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory

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period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden
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